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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,394	10/25/2001	Masaru Hosokawa	215103US0PCT	9972

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EXAMINER
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AZPURU, CARLOS A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/926,394

Applicant(s)

Hosokawa et al

Examiner

Carlos Azpuru

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1615



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 - 6 6) ☐ Other:

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### DETAILED ACTION

Receipt is acknowledged of the information disclosure statements filed 01/25/02, 06/07/02, 07/26/02, and 08/22/02.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by JP60-123416 (JP'416).

JP'416 disclose a transdermal composition comprising a mixture pf polymers which forms a surface-segregated film, and active ingredient. The polymers have different surface tension and are a combination of hydrophobic and hydrophilic polymers, with one being a silicone polymer or a polymer having a fluorinated carbon chain and a hydrophilic polymer. The hydrophilic polymer may be a polyvinyl alcohol (see claims and example 2). The instant claims are anticipated by JP'416.

✓ Claims 1-4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by JP3-11530 (JP'530).

JP'530 disclose a transdermal composition comprising a mixture pf polymers which forms a surface-segregated film, and active ingredient. The polymers have

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different surface tension and are a combination of hydrophobic and hydrophilic polymers, with one being a silicone polymer or a polymer having a fluorinated carbon chain and a hydrophilic polymer. The hydrophilic polymer may be a polyvinyl alcohol (claims; page 6, lines 3-18; page 7, lines 6-15). The instant claims are anticipated by JP'530.

Claims 1-4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5240995 (US'995).

US'995 disclose a transdermal composition comprising a mixture of polymers which forms a surface-segregated film, and active ingredient. The polymers have different surface tension and are a combination of hydrophobic and hydrophilic polymers, with one being a silicone polymer or a polymer having a fluorinated carbon chain and a hydrophilic polymer. The hydrophilic polymer may be a polyvinyl alcohol (see claims 1, 4, 8, 12, and 13). The instant claims are anticipated by US'995.

Claims 1-4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0326278 (EP'278).

EP'278 disclose a transdermal composition comprising a mixture of polymers which forms a surface-segregated film, and active ingredient. The polymers have different surface tension and are a combination of hydrophobic and hydrophilic

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polymers, with one being a silicone polymer or a polymer having a fluorinated carbon chain and a hydrophilic polymer. The hydrophilic polymer may be a polyvinyl alcohol (see Abstract; claims 1-8). The instant claims are anticipated by EP'278.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by EP0524612 (EP'612).

EP'612 disclose a transdermal composition comprising a mixture pf polymers which forms a surface-segregated film, and active ingredient. The polymers have different surface tension and are a combination of hydrophobic and hydrophilic polymers, with one being a silicone polymer or a polymer having a fluorinated carbon chain and a hydrophilic polymer. Specific polymers include an oxazoline-modified organopolysiloxane having an organopolysiloxane segment (a) and a poly(N-acylalkyleneimine) segment bonded to it at the end or side chain via a hetero-atom-containing alkylene group (see page 9, lines 11-15; claims 1-4). The instant claims are anticipated by EP'612.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by EP0640643 (EP'643).

EP'643 disclose a transdermal composition comprising a mixture pf polymers which forms a surface-segregated film, and active ingredient. The polymers have

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different surface tension and are a combination of hydrophobic and hydrophilic polymers, with one being a silicone polymer or a polymer having a fluorinated carbon chain and a hydrophilic polymer. Specific polymers include an oxazoline-modified organopolysiloxane having an organopolysiloxane segment (a) and a poly(N-acylalkyleneimine) segment bonded to it at the end or side chain via a hetero-atom-containing alkylene group (See page 10, line 19; claims 1-17). The instant claims are anticipated by EP'643.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by EP0863172 (EP'172).

EP'172 disclose a transdermal composition comprising a mixture pf polymers which forms a surface-segregated film, and active ingredient. The polymers have different surface tension and are a combination of hydrophobic and hydrophilic polymers, with one being a silicone polymer or a polymer having a fluorinated carbon chain and a hydrophilic polymer. Specific polymers include an oxazoline-modified organopolysiloxane having an organopolysiloxane segment (a) and a poly(N-acylalkyleneimine) segment bonded to it at the end or side chain via a hetero-atom-containing alkylene group (see pages 10-13; examples 1-6). The instant claims are anticipated by EP'172.

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Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP2000-44476 (JP'476).

✓ JP'476 disclose a transdermal composition comprising a mixture pf polymers which forms a surface-segregated film, and active ingredient. The polymers have different surface tension and are a combination of hydrophobic and hydrophilic polymers, with one being a silicone polymer or a polymer having a fluorinated carbon chain and a hydrophilic polymer (see claims). The instant claims are anticipated by JP'476.

✓ Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP62-240612 (JP'612).

JP'612 disclose a transdermal composition comprising a mixture pf polymers which forms a surface-segregated film, and active ingredient. The polymers have different surface tension and are a combination of hydrophobic and hydrophilic polymers, with one being a silicone polymer or a polymer having a fluorinated carbon chain and a hydrophilic polymer (see claims). The instant claims are anticipated by JP'612.

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✓ Claims 1-6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP05-112423 (JP'423).

JP'423 disclose a transdermal composition comprising a mixture of polymers which forms a surface-segregated film, and active ingredient. The polymers have different surface tension and are a combination of hydrophobic and hydrophilic polymers, with one being a silicone polymer or a polymer having a fluorinated carbon chain and a hydrophilic polymer. Specific polymers include an oxazoline-modified organopolysiloxane having an organopolysiloxane segment (a) and a poly(N-acylalkyleneimine) segment bonded to it at the end or side chain via a hetero-atom-containing alkylene group. The hydrophilic polymer may also be a polyvinyl polymer. The examples active ingredients in the formulation. The weight ratio of segments A to B is identical, as well as the weight average molecular weight (see abstract, entire document). The claims are clearly anticipated by JP'423.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos A. Azpuru whose telephone number is 703/308-0237. The examiner can normally be reached on Tu-Fri, 6:30 am - 5:00 pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

ca  
February 4, 2003

  
CARLOS A. AZPURU  
PRIMARY EXAMINER  
GROUP 1500